

08/22/2003 TTAB

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: Laureate Learning Systems, Inc.

Serial No.: 76/226,904

Appellant: Laureate Learning Systems, Inc.

Application Filed: March 20, 2001

Mark: LAUREATE

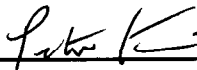
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APPELLANT'S APPEAL BRIEF

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I. INTRODUCTION

This is an appeal from the final rejection of the present application. In the Office Action mailed March 5, 2002, the refusal of registration of Appellant's mark LAUREATE was made final on the basis that the mark, when applied to Appellant's goods, so resembled the mark LAUREATE, contained in Registration No. 1,508,958, as to be likely to cause confusion, or to cause mistake, or to deceive in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

II. JURISDICTION

The jurisdiction of the Trademark Trial and Appeal Board is invoked under the provisions of 15 U.S.C. § 1070 and 37 C.F.R. §§ 2.141 and 2.142.

III. BACKGROUND – PROCEDURAL HISTORY

The present application to register Appellant's mark LAUREATE for educational software was filed in the U.S. Patent and Trademark Office on March 20, 2001. In a first Office Action mailed June 12, 2001, registration on the Principal Register was refused under Trademark Act § 2(d), 15 U.S.C. § 1052(d), based on the determination that Appellant's mark LAUREATE, when used on "educational software for children and adults with special needs, namely applications software providing instruction in the fields of language, cognition, auditory processing and reading", is likely to be confused with the mark LAUREATE, Registration No. 1,508,958, used to identify

educational books containing reference materials, supplementary materials, and discourse on the nature of learning and on the instruction of others with learning problems; and educational services, namely, providing specialized instruction to others in the fields of remedial reading, writing, and mathematics, and study strategies, through the operation of schools; educational consulting services.

Specifically, registration of Appellant's mark was refused based on the finding that the subject marks are identical and the goods identified by the marks are closely related and are used by and for the same consumers, thereby creating a likelihood of confusion as to the source of goods identified by these marks.

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In answer to the first Office Action, Appellant filed a response on December 10, 2001. In this response, Appellant argued that there was no likelihood of confusion as to the source of the goods and services identified by the registered mark LAUREATE and the goods identified by Appellant's mark LAUREATE. In order to alleviate any such potential confusion, Appellant narrowed the description of goods to read as follows:

educational software for children and adults with diagnosed disabilities, consisting of children diagnosed with mental retardation, hearing impairments (including deafness), speech or language impairments, visual impairments (including blindness), serious emotional disturbance, orthopedic impairments, autism, or traumatic brain injury and adults diagnosed with developmental disabilities, aphasia, or closed head trauma; namely interactive applications software providing instruction, through direct intervention, in the fields of language, cognition, auditory processing, and reading.

Appellant then argued that that there is no likelihood of confusion because (a) the goods and services identified by the registered mark LAUREATE are very different from the goods identified by Appellant's mark LAUREATE, (b) any risk of a likelihood of confusion is eliminated because the purchasers of Appellant's goods and Registrant's goods and services are sophisticated, and (c) the word "LAUREATE" is weak.

In the second Office Action mailed March 5, 2002, the previous refusal to register based upon Section 2(d) of the Trademark Act was made final on the grounds that consumers would believe Appellant's goods and Registrant's goods and services come from the same source. In support of this finding, it was determined that the marks themselves are identical and the Appellant's goods are closely related to the goods and services of the Registrant because they are marketed in the same trade channels and the Appellant's goods might be used in the performance of the Registrant's services. Evidence was presented in an attempt to support these determinations.

On September 4, 2002, Appellant filed a Request for Consideration, which was denied on October 4, 2002. On September 6, 2002, Appellant filed a notice of appeal of the refusal to register its mark LAUREATE with the Trademark Trial and Appeal Board. Appellant subsequently filed

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Requests for Additional Three Month Suspensions on October 30, 2002, February 4, 2003 and May 13, 2003, all of which were granted by the Trademark Trial and Appeal Board.

IV. ISSUE ON APPEAL

The following ultimate issue is before the Trademark Trial and Appeal Board in the present matter:

Is Appellant's use of the mark LAUREATE to identify its software (as more particularly described above) likely to confuse average purchasers as to the source of its goods and the source of Registrant's books and services (as more particularly described above) identified by the mark LAUREATE ?

In support of the present appeal, Appellant relies on the following arguments, the arguments made in its previously filed responses, and on other information of record in this case.

V. ARGUMENT

- A. There is no likelihood of confusion because the goods and services identified by LAUREATE are very different from the goods identified by Appellant's mark.

As a general matter, "if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely." TMEP §1207.01(a)(i). As set forth below, there is no likelihood of consumer confusion because Appellant's goods are fundamentally different from Registrant's goods and services.

The goods and services identified by LAUREATE are:

Educational books containing reference materials, supplementary materials, and discourse on the nature of learning and on the instruction of others with learning problems, in International Class 16.

Educational services, namely, providing specialized instruction to others in the fields of remedial reading, writing, and mathematics, and

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study strategies, through the operation of schools; educational consulting services, in International Class 41.

By contrast, the goods identified by Appellant's mark are:

Educational software for children and adults with diagnosed disabilities, consisting of children diagnosed with mental retardation, hearing impairments (including deafness), speech or language impairments, visual impairments (including blindness), serious emotional disturbance, orthopedic impairments, autism, or traumatic brain injury and adults diagnosed with developmental disabilities, aphasia, or closed head trauma; namely interactive applications software providing instruction, through direct intervention, in the fields of language, cognition, auditory processing, and reading, in International Class 9.

Registrant's goods and services differ from Appellant's goods in several important ways. As a threshold issue, however, the mere fact that Registrant and Appellant are engaged in education-related businesses is not a sufficient ground upon which to conclude that Registrant's goods and services are so related to Appellant's goods as to give rise to a likelihood of confusion. At least one federal court has affirmatively stated that employing a category as broad as "education" is inappropriate for a likelihood of confusion analysis. Mejia and Associates, Inc. v. International Business Machines Corp., 920 F. Supp. 540, 548 (S.D.N.Y. 1996) (finding that use of "educational services" as a classification was "meaningless for purposes of determining that the products are proximate"); Alta Vista Corp., Ltd. v. Digital Equip. Corp., 44 F.Supp. 2d 72, 77 (D. Mass. 1998) (approving the *Mejia* Court's analysis). The fact that both Appellant's goods and Registrant's goods and services serve the purpose of education is not enough to justify a finding that there is a likelihood of confusion.

More specifically, compare Appellant's software to the "educational books" identified by the mark LAUREATE. Registrant's books contain "reference materials, supplementary materials and discourse on the nature of learning and on the instruction of others with learning problems."

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Registrant's books would therefore be used to teach educators how to teach persons with learning problems.

By contrast, Appellant's software is physically used in an interactive manner by (i) children diagnosed with mental retardation, hearing impairments (including deafness), speech or language impairments, visual impairments (including blindness), serious emotional disturbance, orthopedic impairments, autism, or traumatic brain injury; and (ii) adults diagnosed with developmental disabilities, aphasia, or closed head trauma (collectively, "Persons with Diagnosed Disabilities"). Persons with this specific set of disabilities are considered distinct from others with learning problems, and as such are singled out in the Individuals with Disabilities in Education Act for special educational entitlements (see the definition of the term "child with a disability" in footnote 2, infra). Appellant's software is used by Persons with Diagnosed Disabilities in order to enable such persons to learn despite the disabilities. Thus, Appellant's software is used in an entirely different field than Registrant's books.

As stated above, Registrant's books are used by educators to teach them how to instruct persons with learning problems. Persons with "learning problems" do not include Persons with Diagnosed Disabilities. As further discussed below, mere learning problems are very different from disabilities. Disabilities, unlike learning problems, are permanent and can be addressed, but not "solved." For example, Appellant's software is physically used by persons with visual impairments and hearing impairments. These are permanent disabilities. Visual impairments and hearing impairments are not "learning problems." Visual impairments and hearing impairments cannot be "solved." Thus, Appellant's software is used in a specialized field that is distinct from the field of "learning problems" in which Registrant's books are used. Educators using Registrant's books to learn how to teach others with learning problems would not purchase nor use Appellant's software.

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In addition, Appellant's software is a tool used specifically by Persons with Diagnosed Disabilities. Registrant's books are not used by students at all. Registrant's books are directed to teaching teachers how to teach.

Finally, Appellant's goods are used on computers in an interactive manner. Registrant's goods are simply read and are not used in an interactive manner.

Importantly, at least one court has treated educational software and educational print literature as non-competing and un-related goods, and therefore found no likelihood of confusion, even where the marks were identical. In Mejia and Associates., Inc. v. International Business Machines Corp., 920 F. Supp. 540, 548 (S.D.N.Y. 1996), a company that provided educational services and promotional materials to adults on starting and running home-based businesses under the mark "EDUQUEST" brought suit against IBM, based on IBM's use of the mark "EDUQUEST" to identify children's educational software.

The Court, ruling for IBM, found no likelihood of confusion. The court reasoned that the plaintiff's services were not competitive with IBM's, *inter alia*, because (1) the bulk of the plaintiff's trade involved educational services rather than products; (2) plaintiff's services were targeted at adult learners (including some schoolteachers) for their own benefit (e.g., to "enhance their professional skills"), rather than to act as a teaching supplement for the benefit of students; and (3) IBM's products were offered through "the media of computer hardware and software," rather than through the more interpersonal and grass roots approach of workshop and seminar offerings. Id. at 547-49. The Court emphasized that the use of high tech media to deliver the educational materials was particularly significant, even though the plaintiff's print-based seminar materials sometimes addressed the uses of technology in home business. Id. at 549 n.13.

Further support for the importance of the distinction between educational print literature (such as that of Registrant) and educational software (such as that of Appellant) is found in the

Principal Register. For example, the USPTO has determined that the mark TEACHER'S TOOLS, Reg. No. 2,402,035, to identify educational software featuring interactive tutorials for high school and college and level subjects can co-exist with the mark TEACHER'S TOOLBOX, App. Serial No. 75/757,585 (published for opposition) for instructional books, manuals and workbooks relating to teaching mathematics with computer software. Although this example is not dispositive, Appellant notes that in this case, the sets of goods identified by the two marks are more related than those of Appellant and Registrant. Additional examples from the Principal Register are set forth in Exhibit A to Appellant's response to Office Action filed on December 10, 2001. These examples demonstrate that registrations by independent owners for identical or highly similar marks identifying educational goods delivered using different media (e.g., interactive software as opposed to print literature) can co-exist without a likelihood of confusion. Similarly, highly related registered trademarks can identify different products and services involving education.

The mere theoretical possibility that Registrant could migrate from its book business (aimed at teaching teachers) to interactive educational software is not a sufficient ground upon which to find that Registrant's books are related to Appellant's software. The plaintiff in Mejia tried to argue that it hoped to eventually develop educational CD-ROMs and on-line educational services, even though its business was grounded in live presentations and print-based materials. See Mejia, 920 F.Supp. at 549. The Court responded by noting that the plaintiff had not thoroughly investigated the technical and financial obstacles to becoming an electronic product or service provider, and accordingly was "in no serious position to attempt to carry out these ideas." Id. It further determined that expansion into CD-ROM technology "would take resources and research and development far beyond plaintiff's present capacity." Id.

As the Mejia Court recognized, such an expansion is a major undertaking, requiring financial investment, hiring of computer programmers and other technical personnel, and a totally different

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approach to marketing. Consequently, it cannot be inferred from the description of Registrant's goods that Registrant will expand its educational books into software, much less Appellant's line of interactive software applications used by Persons with Diagnosed Disabilities. The Mejia case and the examples in Exhibit A to Appellant's response to Office Action filed on December 10, 2001, demonstrate that identical or related marks for educational software on the one hand, and printed educational materials on the other, can co-exist without customer confusion.

Finally, Appellant notes that Registrant's "educational books" - - intended to teach teachers how to teach - - are not competitive with Appellant's software. Although there can be a likelihood of confusion among non-competitive goods, this lack of competition further reduces the risk of a likelihood of confusion.

Next, consider the differences between Appellant's software goods and the "educational services" identified by Registrant's mark LAUREATE. Importantly, Appellant's services are provided "through the operation of schools." Use of a mark to identify schools and use of a mark to identify an interactive software application is unlikely to give rise to consumer confusion. Moreover, Registrant's other services are "educational consulting services." These services are (like Registrant's educational books) likely intended to teach teachers how to teach. These services are very different from an interactive software application.

Appellant respectfully submits that the Office Actions overstated the connection between the content that Registrant may impart to its students as part of its "educational services" provided "through the operation of schools" and the content delivered by Appellant through its interactive software applications. The educational services offered by Registrant "through the operation of schools" provide "specialized instruction to others in the fields of **remedial** reading, writing, and mathematics" (emphasis added.) The term "remedial education" is recognized among educational

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professionals as referring to learning difficulties in the general population, as opposed to disabilities.¹ Remedial education is targeted to students who have not had an opportunity for learning, due to inadequate teaching or an unfavorable home environment that is not conducive to learning. For example, the federal Headstart program is perhaps the nation's best known remedial education program. Thus, it can be inferred from Registrant's description that the students in the schools operated by Registrant will be those in the general school population who, due to lack of learning opportunities or due to an unfavorable environment, require remedial help with reading and other subjects in order to catch up with their peers.

By contrast, the users of Appellant's software, as reflected in Appellant's amended identification of goods, are Persons with Diagnosed Disabilities. A student with a disability is recognized among educational, medical, and legal professionals as requiring distinct and specialized assistance in learning.² Educators regularly distinguish this type of student from weaker students, or "slow learners," who require remedial reading and other classes.³

¹ See PETER BURKE AND KATY CIGNO, *LEARNING DISABILITIES IN CHILDREN* 14 (2000). The authors explain that the term "learning disability" refers to "actual intellectual impairment" and is distinguished from the term "learning difficulties", which every person has in relation to some aspect of daily life." *Id.* The author goes on to explain that learning difficulties are generally addressed through remedial education. *Id.*

² See, e.g., Robert J. Sternberg, "Toward an Emerging Consensus About Learning Disabilities" in *PERSPECTIVES ON LEARNING DISABILITIES: BIOLOGICAL, COGNITIVE, CONTEXTUAL* 277-281 (1998) (identifying points on which theorists, researchers, and educational practitioners agree in debate over learning disabilities); 2 *ENCYCLOPEDIA OF SPECIAL EDUCATION* 1071-75 (2nd ed. 2000) (describing history of recognition of learning disabilities among doctors, educators, and attorneys); see also 20 U.S.C. § 1401 (3)(A) (defining, for purposes of the Individual with Disabilities in Education Act ("IDEA"), a "child with a disability" as a child with "mental retardation, hearing impairments (including deafness), speech or language impairments, visual impairments (including blindness), serious emotional disturbance ..., orthopedic impairments, autism, traumatic brain injury, other health impairments, or specific learning disabilities."); Jean Lokerson, *Learning Disabilities: Glossary of Some Important Terms*, available at www.ldonline.org/ld_indepth/glossaries/gloassary_of_terms.html (describing and defining specific learning disabilities, including aphasia, dyscalculia, dysgraphia, dyslexia, dysnomia, and dyspraxia).

³ See, e.g., BURKE AND CIGNO, *supra*, at 14 (distinguishing "learning disabilities" from "learning difficulties"); National Institute of Mental Health, *Learning Disabilities*, 3, available at www.nimh.nih.gov/publicat/learnedis.htm ("To be diagnosed as a learning disability, specific criteria must be met."); Michael E. Spagna, "All Poor Readers Are Not Dyslexic," in *LEARNING DISABILITIES: CONTEMPORARY VIEWPOINTS* (1996) (discussing 1983 study documenting recognized learning disabilities, and "other learning problems," a category including language interference, slow learners, environmental causes, and minor behavioral problems); NEWELL C. KEPHART, *THE SLOW LEARNER IN THE CLASSROOM* (2nd ed. 1971) (discussing slow learners who are not disabled); JEROME H. BRUNS, *THEY CAN BUT THEY WON'T* (1992) (explaining work inhibition among non-disabled

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Appellant's customers consist of professional educators and therapists. Appellant's goods do not address the needs of slow learners who require remedial education. Thus, the content of Appellant's goods is very different from the content of Registrant's educational services. Because of this difference in content, there will likely be no overlap among purchasers of Appellant's goods (professional educators and therapists involved in educating Persons with Diagnosed Disabilities), and purchasers of Registrant's services (parents who send their children to schools that provide remedial education for weaker or slow students and perhaps professional educators who refer students to Registrant's schools). Thus, there is no evidence that the same persons would encounter both marks, thereby eliminating the risk of a likelihood of confusion. Accord Mejia, 920 F.Supp. at 548 ("The question is whether the parties offer their products to the same market audience, not whether participants in one market may coincidentally be consumers in another."); RICHARD L. KIRKPATRICK, LIKELIHOOD OF CONFUSION § 6.1, 6-1 (2000) ("[T]here must be a reasonable basis for finding that the marks would be encountered by the same persons other than by chance.").

B. Appellant's goods and the Registrant's goods and services are not marketed in the same channels of trade.

The Office Action mailed on March 5, 2002 states that the Appellant's educational software is marketed in the same trade channels as Registrant's books and Registrant's services. Appellant respectfully submits that the evidence provided in the Office Action mailed on March 5, 2002 does not support this conclusion. The third party registrations cited in the Office Action mailed on March 5, 2002 show only that certain vendors sell both software and printed material under the same trademark. Appellant does not contest this. Indeed, many sellers of software also offer printed materials such as user guides or documentation as a companion to their software. These printed materials describe the installation, use and maintenance of the software. The TIME TOWN

students); STERNBERG, *supra*, at 278 (noting that many children are wrongly labeled as learning disabled when they are simply slow learners).

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registration, cited by the Office Action mailed on March 5, 2002, is an example. The mark TIME TOWN is registered for "educational software" in Class 9 and "printed matter, namely computer teaching manual" in Class 16. The fact that software vendors often sell companion printed material does not, however, establish that Registrant's goods and services -- books that teach teachers how to teach, and educational services consisting of operating schools and consulting to educators -- would be sold through the same trade channels as Appellant's educational software used by persons with disabilities.

The evidence from Nexis excerpts attached to the Office Action mailed on March 5, 2002 does not establish that Registrant's services -- operating schools and consulting to educators -- would be promoted or sold in the same trade channels in which educational software is promoted and sold. Indeed, not one of the Nexis excerpts mentions a business that operates schools or provides educational consulting. One Nexis excerpt does reference a single building within a housing development operated by a governmental housing authority that offers computer classes and educational software. But the existence of this facility hardly establishes that Appellant's software and Registrant's services (comprised of operation of schools and educational consulting) are provided through the same channels of trade.

Appellant acknowledges that if a registration describes goods or services broadly, and there is no limitation to the channels of trade, the Examining Attorney will presume that the Registrant's goods move in all normal channels of trade. Here, however, Appellant respectfully submits that this presumption has been overcome. To Appellant's knowledge, the Registrant's goods and services are not sold in any of the trade channels used by Appellant to sell its software goods. Appellant's trade channels are as follows: (i) a catalog mailed to educators, administrators and therapists nationwide four times a year that refers purchasers to a toll free number (approximately 400,000 pieces in each mailing); (ii) a network of approximately 30 vendors of educational technology (some of whom carry

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some printed materials); (iii) advertising in periodicals published by the American Speech-Language-Hearing Association and the International Association for Augmentative and Alternative Communication; (iv) numerous trade shows, including those sponsored by the Assistive Technology Industry Association, the National Conference on Autism, the American Speech-Language-Hearing Association and the Florida Educational Technology Conference; and (v) sales directly from Appellant's website at www.laureatelearning.com.

To Appellant's knowledge, Registrant does not sell its products in any of the foregoing trade channels. Specifically, to Appellant's knowledge, Registrant does not have a toll free number; none of the vendors of education technology used by Appellant as dealers for its software goods offer any of Registrant's goods or services; Registrant does not advertise in any of the publications in which Appellant advertises its goods; Registrant does not sell or promote its goods at any of the trade shows that Appellant attends; and Registrant does not have a website nor are its goods or services available for purchase over the Internet.

Appellant respectfully submits that this evidence overcomes any theoretical possibility that Appellant's software would be sold in the same trade channels as Registrant's books and services.

C. Any risk of a likelihood of confusion is eliminated because the purchasers of Appellant's goods and Registrant's goods and services are sophisticated.

The sophistication of the purchasers of both Registrant's goods and services, and Appellant's goods, eliminates the risk of a likelihood of confusion. First, consider Registrant's "educational books." These books are intended to teach professional educators how to instruct persons with learning problems. Professional educators are likely to be extremely discriminating in selecting the materials they use to develop their curricula and teaching strategy. Next, consider Registrant's services, consisting of "specialized instruction" in "remedial reading, writing, and mathematics, and study strategies, through the operation of schools." The decision to send students to Registrant's schools would likely be made by professional educators or the student's parents (or perhaps both, in

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consultation with each other). Again, the decision to send someone to one of Registrant's schools for remedial instruction would not be made lightly. It would be made after much consideration and likely with input from professionals.

Appellant's goods are purchased exclusively by professional educators and therapists. These professional educators and therapists are acutely aware of the challenges faced by Persons with Diagnosed Disabilities. Professional educators and therapists recognize that Persons with Diagnosed Disabilities can only be properly educated with learning materials designed specifically for them.⁴ The purchasers of Appellant's software are highly sophisticated, and will be cognizant of the difference between educational materials designed for students with disabilities, and those targeted directly or indirectly at non-disabled students. They will approach the decision of how to address the learning disabilities of their clients and students with great care. Accord J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:101 at 23-236 (noting that professionals are sophisticated enough not to be confused by trademarks that are closely similar); id. § 23:103 at 23-243, 244 (noting that only when products and marks are absolutely identical will likelihood of confusion extend to professional buyers); Astra Pharmaceutical Prods., Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 1206-07 (1st Cir. 1993) (finding no infringement in case involving ASTRA local anesthetic preparation versus ASTRA computerized blood analyzer machine).

While it is true that Appellant's products are not expensive individually, professional educators and therapists will often be purchasing Appellant's software products to furnish the special education department of a school or school district. Professional educators and therapists very often

⁴ See, e.g., THE COMPLETE LEARNING DISABILITIES DIRECTORY (Ed. Laura Mars 1997) (listing associations, newsletters, magazines, books, tapes, products, and services for parents, students, and professionals relating to the learning disabled); see also John W. Lloyd, Recurring Themes in Learning Disabilities, 2, available at <http://curry.edschool.virginia.edu/go/lnrdis/classes/LDthemes.html> ("There is increasing evidence that learning disabilities are developmental disabilities, that is, that they are evident early in many children's lives and that they persist into adulthood. To the extent that this is true, [a learning disability] probably is not curable in the sense that a disease or unfortunate life circumstance might be."); BURKE & CIGNO, *supra*, at 8 (noting that most intellectual disabilities and certain physical disabilities impairing the individual's ability to learn are incurable).

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face budgeting restraints in purchasing products for their school, meaning they are even more likely to be more discerning in making the purchase. See MCCARTHY ON TRADEMARKS § 23:95 at 23-226 (“If the goods or services are **relatively expensive**, more care is taken and buyers are less likely to be confused as to source or affiliation”) (emphasis added).

Federal courts have addressed the “sophistication of buyers” analysis for other marks on products and services developed for the general child population, and those marketed to the disabled. In Heartsprings v. Heartspring, 143 F.3d 550 (10th Cir. 1998), the Court of Appeals for the Tenth Circuit found that educators and parents were unlikely to confuse the plaintiff’s use of the mark HEARTSPRINGS for educational materials, namely, literature for schoolchildren illustrating methods of avoiding violent confrontations or effecting non-violent conflict resolution, with defendant’s use of HEARTSPRING for a school for children with physical disabilities. Both the District Court and Court of Appeals reached the same conclusion regarding competition:

Defendant Heartspring . . . markets basic skills training to a **specialized population, the physically handicapped**, whereas plaintiff Heartsprings markets publications devoted to nonviolent training for use with the **general child population** . . . [Consequently,] the parties are not competitors and do not provide products for the same groups of consumers.

Id. at 556-557 (emphasis added). More importantly, the Court of Appeals noted that the defendant’s consumers were more sophisticated than the plaintiff’s because the former “must be willing to entrust their physically disabled children to defendant’s care and supervision[.]” Id. at 557.

The principles discussed in Heartsprings apply equally in this case. Professional educators and parents searching for schools to provide remedial education, and professional educators searching for books to help them develop their curricula, are much like the consumers of Defendant Heartspring’s services for the physically disabled. Likewise, professional educators and therapists searching for software for their students and clients are analogous to the consumers of Defendant Heartspring’s services for children with physical disabilities. Their sophistication stems from the

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necessary degree of care involved in their decisions due to pedagogical and financial concerns. In addition, with respect to Registrant's goods and services, there are significant and foreseeable risks stemming from picking an inappropriate educational book to develop one's curriculum, as well as picking an inappropriate school. This same level of care, and this same perception of the risks, applies to the professional educators and therapists who would purchase Appellant's goods. Thus, given the sophistication and level of care likely to be exercised by purchasers of both Registrant's goods and services and Appellant's goods, a likelihood of confusion is avoided.

D. The risk of a likelihood of confusion is reduced because the word "LAUREATE" is weak.

The risk of a likelihood of confusion between LAUREATE and Appellant's mark is much reduced because LAUREATE is a weak term when used in the field of education. LAUREATE is weak for two reasons: (i) it is a laudatory term and therefore largely descriptive and (ii) it is in common use.

The word LAUREATE is not coined or arbitrary. The primary meaning of the word LAUREATE is "worthy of the greatest honor or distinction." *The American Heritage Dictionary of the American Language* (3rd Ed. 1996). LAUREATE also means "the recipient of honor for achievement in an art or science." See MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY, 645 (2nd ed. 1981). Thus, the term conveys the immediate impression that the goods or services it identifies are entitled to honor or distinction. In other words, when used as a trademark, LAUREATE immediately tells the purchaser that the goods or services are of high quality. The term LAUREATE is thus analogous to the other terms that have been found by courts and the Trademark Trial and Appeal Board to be self-laudatory (and hence descriptive) such as PLATINUM, BLUE RIBBON, GOLD MEDAL, PREFERRED, and DELUXE. See *McCarthy on Trademarks* § 11:17. As a descriptive term, LAUREATE is only entitled to a narrow scope of trademark protection.

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The Office Action mailed June 12, 2001 concluded that LAUREATE did not function as a laudatory expression as applied to the goods, because the term LAUREATE refers to a person who is honored or noted as being worthy of highest distinction. Appellant does not dispute that the word LAUREATE is often used to refer to a person (or a group of persons) who is honored or noted as being worthy of highest distinction. Examples of such use are attached as Exhibit C to the Request for Reconsideration filed on September 4, 2002. Indeed, the terms "Nobel laureate" and "poet laureate" are commonly used terms in the English language. However, the distinction drawn by the Office Action -- namely, that the term "LAUREATE" often applies to persons and not goods or services -- in no way detracts from the fact that consumers will perceive LAUREATE as a laudatory term. As stated in Section 1209.03(k) of the TMEP, "Laudatory terms, those that attribute quality or excellence to goods or services, are . . . descriptive under § 2(e)(1)." Appellant respectfully submits that when the word LAUREATE is used as a mark to identify goods and services (as noted in the above-cited examples of third party registrations and uses of LAUREATE), it does nothing more than "attribute quality or excellence" to such goods and services. The consumer need not exercise any imagination to conclude that this is the meaning of LAUREATE. This function is the hallmark of a descriptive term. For this reason, LAUREATE is a weak mark.

Even if the Examining Attorney maintains her view that the term LAUREATE is not a descriptive term, and believes that it is instead suggestive, it is to be noted that this analysis can be very subjective. The line between descriptive terms and suggestive terms is not well defined, and is in fact a continuum. See *McCarthy on Trademarks*, § 11:66. Thus, even if the Examining Attorney concludes that LAUREATE is a suggestive word, it is still relatively weak, because it retains a pronounced descriptive meaning.

The term LAUREATE is also weak because it is in common use in the field of education. Under Amstar Corporation v. Domino's Pizza, Inc., 205 U.S.P.Q. 969, 975-76 (5th Cir. 1980),

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evidence of third party uses and registrations of identical or related marks limits the protection to be accorded to an owner of a mark outside the uses to which that owner has already put its mark. The T.T.A.B.'s holding in Keebler Co. v. Associated Biscuits Ltd., 207 U.S.P.Q. 1034 (T.T.A.B. 1980) provides an application of this principle. In Keebler Co., the T.T.A.B. found no likelihood of confusion between CLUB for crackers and JACOB'S CLUB for chocolate biscuits. The T.T.A.B. found that numerous third party registrations "show a commercial attractiveness and popularity possessed by 'CLUB' for foods and beverages to an extent where it is far too late for any one party to claim a right to exclusive use extending beyond a specific mark for specific goods." Keebler Co., 207 U.S.P.Q. at 1039. The T.T.A.B. concluded that the "petitioner's 'CLUB' mark for crackers is only entitled to only a very circumscribed scope of protection limited to essentially the same mark for essentially the same goods." Id.

Here, there are third party registrations and evidence of third party use of terms that include LAUREATE in the field of education, educational materials, and related fields. These registrations and uses underscore the weakness of LAUREATE. These registrations and uses include:

- LAUREATE, Reg. No. 2356146, to identify "assessing employee performance and **student academic or training performance for educational institutions**, governmental agencies, human resources, and corporate training and management," owned by Laureate Inc. (emphasis added).
- LAUREATE, Reg. No. 2352697, to identify "computer programs for **performance and outcome assessment in educational institutions**, governmental agencies, human resources, corporate training and management for use on global and local computer networks," owned by Laureate Inc. (emphasis added).
- LAUREATE, Reg. No. 1763417, to identify "hospital, medical clinic, health care, physician, medical counseling, psychiatric consulting, psychological counseling services; **medical laboratory and research**, pharmacy and physical therapy services; services in the field of mental health and chemical dependency; alcoholic and chemically addicted patient rehabilitation services," owned by Laureate Psychiatric Clinic and Hospital, Inc. (emphasis added).

- SALLIEMAE LAUREATE, Reg. No. 2367752, to identify “financial services, namely, **student loan processing**, approval and administration services,” owned by Sallie Mae, Inc. (emphasis added).
- KNOT LAUREATE, Reg. No. 2321424, **books, booklets and bulletins** relating to knots of different types, owned by Roger Ford (emphasis added).
- THE LAUREATE PRIVATE SCHOOL, a **private school** serving children from toddler age to eighth grade, in San Luis Obispo, CA (See Exhibit C to Appellant’s response to Office Action filed on December 10, 2001).
- THE LAUREATE GROUP, providing consulting services related to the installation of healthcare information systems and **education** in the use of such systems, based in South Burlington, VT (See Exhibit C to Appellant’s response to Office Action filed on December 10, 2001).

Copies of print-outs from the TESS database for the registrations listed above are attached as Exhibit A to the Request for Reconsideration filed on September 4, 2002. Evidence of the third party uses of LAUREATE are also attached as Exhibit A to the Request for Reconsideration filed on September 4, 2002.

Note that the number of third party marks is not determinative. See Smithkline Beecham Corporation v. Proctor & Gamble Company, 223 U.S.P.Q. 1230, 1235 (N.D.N.Y. 1984) (as few as two related marks used to identify similar goods can weaken a mark). At issue is whether these marks show “that the term or feature common to the marks has a normally understood meaning or suggestiveness in the trade.” In re Hamilton Bank, 222 U.S.P.Q. 174, 177 (T.T.A.B. 1984).

The weakness of Registrant’s mark LAUREATE is underscored by the existence of other third party registrations and third party uses that include LAUREATE and appear to have the exact same descriptive meaning. These third party registrations and uses include:

- LAUREATE, Reg. No. 1854470, to identify “sterling silver flatware...,” owned by Towle Manufacturing Company.
- LAUREATE, Reg. No. 2551069, to identify “woodwind instruments,” owned by G. Leblanc Corporation.
- LAUREATE HOMES, Reg. No. 2573125, to identify “construction of single-family and multi-family homes...,” owned by U.S. Home Corporation.

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- LAUREATE, Reg. No. 1705863, to identify "furniture," owned by Councill Craftsmen, Inc.
- LAUREATE, Appl. No. 76368054, to identify "watches and parts thereof," owned by Westfield Licensing Company (this pending actual use application was published for opposition on July 23, 2002).
- LAUREATE CAPITAL, to identify mortgage banking services in 43 states and having an office in Atlanta, Georgia.
- LAUREATE PHARMA, to identify manufacturing pharmaceutical products, with facilities in Princeton, New Jersey and Totown, New Jersey.
- LAUREATE CITIES, to identify cities that receive an award from the United Nations.
- LAUREATE, to identify digital panel meters, counters and remote displays, sold by Laurel Electronics, Inc. of Costa Mesa, California.

Copies of print-outs from the TESS database for the registrations listed above are attached as Exhibit B to the Request for Reconsideration filed on September 4, 2002. Evidence of third party uses of LAUREATE are also attached as Exhibit B to the Request for Reconsideration filed on September 4, 2002. Appellant acknowledges that these third party marks and these third party uses do not identify products or services in the field of education. However, they are probative of the general weakness of the word LAUREATE. See Amstar Corporation, 205 U.S.P.Q. 969 at 975-76. They also show that LAUREATE is dilute.

In sum, LAUREATE is a weak term because it is in common use and because it is descriptive. Accordingly, this weakness will enable consumers to distinguish the marks. Thus, a likelihood of confusion between Appellant's mark for software and Registrant's mark for books and services is avoided.

E. The risk of a likelihood of confusion is reduced by the absence of actual confusion.

Appellant respectfully submits that the risk of a likelihood of confusion between Appellant's mark and Registrant's mark LAUREATE is reduced by the absence of any actual confusion.

It is black letter law that an absence of actual confusion, or weak evidence of actual confusion, can weigh against a finding of actual confusion. See Aktiebolaget Electrolux v. Armatron

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International Inc., 27 U.S.P.Q. 2d 1460, 1462 (1st Cir. 1993) (“weak evidence of actual confusion weighs quite heavily against a finding of likelihood of confusion”). This factor is particularly probative if such absence of confusion persists despite a period of simultaneous use of the marks in question. Id.; see also Al-Site Corp. v. VSI International Inc., 50 U.S.P.Q. 2d 1161, 1177 (Fed. Cir. 1999). An absence of actual confusion may be considered in an ex parte proceeding, even though the registrant is not heard. In re General Motors Corp., 23 U.S.P.Q. 2d 1465, 1471 (T.T.A.B. 1992) (In ex parte proceeding, applicant’s assertion of the absence of any reported instance of actual confusion weighs against a finding that applicant’s mark is likely to cause confusion.).

Despite Appellant’s extensive nationwide sales of its goods since October 1982, and despite the fact that Registrant’s registration issued in October 1988, to Appellant’s knowledge, there have been no instances of actual confusion. Nor has the Registrant issued any complaints to Appellant regarding a likelihood of confusion. Appellant believes that given Appellant’s long, continuous and extensive use of LAUREATE, this absence of any actual confusion indicates that any risk of a likelihood of confusion is extremely low.

VI. CONCLUSION

For all of the reasons set forth above, Appellant respectfully submits that it has resolved all issues raised in the Office Action and requests that the above-identified mark be passed to publication.

Respectfully submitted,

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